

REMARKS

Claims 5-10 are pending in the application. Claim 5 has been amended to incorporate the original recitation of claim 1.

Entry of the amendment is respectfully requested.

Initially, the Examiner is respectfully requested indicate whether the drawings filed on December 17, 2003 have been accepted.

I. Response to Rejection of Claims 1-10¹ under 35 U.S.C. § 103(a)

At pages 2-3 of the Office Action, claims 5-10 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tani et al. (US Patent 5,972,807) in view of Yamamoto et al. (US. Patent 6,387,969).

Without acquiescing to the merits of the rejection, it is respectfully submitted that Yamamoto et al. is assigned to Nitto Denko Corporation and issued on May 14, 2002, which is after the November 27, 2000 effective U.S. filing date of the present application (i.e., filing date of parent application 09/721,666; now US Patent 6,696,529). Therefore, Yamamoto et al. is potentially a reference only under 35 U.S.C. § 102(e).

The inventive entity of Yamamoto et al. and the present invention are the same, and the disclosure being relied upon by the Examiner is not "by another" as required by 35

¹ We note that claims 1-4 have been canceled in a Preliminary Amendment.

U.S.C. § 102(e). Therefore, Yamamoto et al. is not prior art under 35 U.S.C. § 102. Also, even if Yamamoto et al. were a reference under 35 U.S.C. § 102(e), the present invention and Yamamoto et al were both owned by Nitto Denko Corporation at the time the present invention was made, so based on 35 U.S.C. § 103(c), the present invention cannot be rejected as obvious over a combination of references including Yamamoto et al.

Accordingly, removal of Yamamoto et al. as a reference and withdrawal of the rejection is respectfully requested.

II. Response to Rejection of Claims 5-10 under 35 U.S.C. § 112, second paragraph

At page 4 of the Office Action, claims 5-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because there is insufficient antecedent basis for the recitation "photosensitive composition according to claim 1."

Claim 5 has been amended to incorporate the recitation of original claim 1. In view of the amendment, withdrawal of the rejection is respectfully requested.

III. Conclusion

For the foregoing reasons, reconsideration and withdrawal of the §103 and §112 rejection, and allowance of claims 5-10 are respectfully requested.

**AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 10/736,529**

Attorney Docket Q78606

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Keiko K. Takagi
Registration No. 47,121

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
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